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10/042,802	01/09/2002	William Grey	YOR920010481US1	5113
48175	7590	08/03/2005	EXAMINER	
BMT/IBM FIVE ELM STREET NEW CANAAN, CT 06840			ALLEN, WILLIAM J	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 08/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/042,802	<b>Applicant(s)</b> GREY ET AL.	
	<b>Examiner</b> William J. Allen	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01/09/2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 27-41 and 43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 and 42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 27-41 and 43 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following groups is required under 35 U.S.C. 121:
  - I. Claims 1-26 and 42, drawn to group I, classified in class 705, subclass 26.
  - II. Claims 27-34, drawn to group II, classified in class 705, subclass 26.
  - III. Claims 35-41, drawn to group III, classified in class 705, subclass 26.
  - IV. Claim 43, drawn to group IV, classified in class 705, subclass 26.
2. The inventions of groups I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention II has separate utility such as fulfilling an order for a product (i.e. some type of notification by the seller, a shipment process, etc.) See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. The inventions of groups I and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as completing an order for a product (i.e. providing an electronic receipt, acknowledging product delivery by the buyer, etc.). See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. The inventions of groups I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the invention of group I is a method for developing an order for a product. The subcombination has separate utility such as providing an executable program that facilitates an order for at least one product (i.e. online purchasing).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

5. The inventions of groups II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as completing an order through exchanging specific components (i.e. replacing one component with another for an entire order). See MPEP § 806.05(d).

Because these inventions are distinct for the reasons given above and have

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acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. The inventions of groups II and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the invention of group I is a method for fulfilling an order for a product. The subcombination has separate utility such as providing an executable program that facilitates an order for at least one product (i.e. online purchasing).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

7. The inventions of groups III and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the invention of group I is a method for completing an order for a product. The subcombination has

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separate utility such as providing an executable program that facilitates an order for at least one product (i.e. online purchasing).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

8. During a telephone conversation with Nandu Talwalker on July 7, 2005 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-26 and 42. Affirmation of this election must be made by applicant in replying to this Office action. Claims 27-41 and 43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Specification***

9. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

10. The disclosure is objected to because of the following informalities: Line 11 of page 26 makes reference to the supplier information database of figure 5. The supplier information database should be labeled as number 274 in the text.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**11. Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

- Per Claim 4 and 5, the Examiner notes the following indefinite terminology:

“projected supply” relates to activities that are implied and not positively recited.

As such, the term refers to activities that occur outside the metes and bounds of the claims. For examination purposes, the Examiner will interpret this term to refer to lead time or other associated issues that might impact a customer receiving the order.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**12. Claims 1-7, 9-12, 15-19, 24, and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Henson (US 6,167,383 herein referred to as Henson).**

Henson teaches all of the limitations of claims 1-7, 9-12, 15-19, 24, and 26. For example, Henson discloses a web-based online store that enables users to custom configure orders based on user-identified criteria [see at least: col. 2, lines 61-63, lines 66-67].

**Pertaining to Claims 1-3:**

- Establishing an order for a product, wherein said order includes a first component associated with said product and said order includes a non-binding attribute associated with said first component. Establishing orders in multiple ways, including but not limited to “receiving an order for a product” during checkout [see at least: col. 5, lines 15-18], allowing the user to “select a plurality of components” for the system [see at least: Figures 3A, 3B, and 3C; col. 6, lines 19-21], providing multiple options per component, etc. The invention also includes “merchandising recommendations” for the available options (i.e. components) and their respective details (i.e. characteristics and attributes) [see at least: col. 3, lines 12-14].
- Determining a second component that satisfies said non-binding attribute for said order; and exchanging said first component with said second component in said order. Henson further facilitates the interchanging of components by allowing customers to view product information, customize the product, price the newly customized product, and purchase the customized product [see at least: col. 4, lines 43-46] in order to advantageously enable system configuration and ordering.



[see at least: col. 4, lines 60-61]. The user interface provides a means of exchanging components within the product as determined by the user based on user-selected criteria [see at least: Figures 3A, 3B, and 3C].

- Order comprises a legal contract. Removal of a screen displaying the terms and conditions of the business lease because the “at-home online buyer does not typically want to read through the terms and conditions of the business lease” [see at least: col. 12, 36-39] 0

**Pertaining to claims 4 and 5:**

- Determining a need for said first component outside said order wherein said determining a need for said first component. Henson further discloses a configurator that includes a warning indicator for notifying the customer that an option they have selected is “subject to adversely impacting shipping” [see at least: col. 3, lines 30-33]. The aforementioned shipment indicator provides customers with “lead time” warnings or shipment delays as a result of their selection [see at least: col. 6, 36-38]. This pertains directly to “determining that an order cannot be completely filled due to a shortage” of one of the selected components, determining that a “projected supply” for one of the offered components may adversely affect the fulfillment of the order, etc.

**Pertaining to Claims 6, 7, 9, and 10:**

- Determining a second component that satisfies said non-binding attribute for said order includes... The determination of a second component satisfying a non-binding attribute is exemplified by the customer's ability to select from "a plurality of components in said order" through use of the user interface based on option details [see at least: col. 6, lines 19-21]. Furthermore, "notification of at least one product satisfying the non-binding attribute" is provided as illustrated in Figures 3A-3C of Henson, as well as "notification of availability" by the interface as outlined in paragraph 13 of this paper. In addition, by selecting one component from the multiple components, the user is "requesting an exchange" of components, "providing consent" for that exchange (which is subsequently received by the supplier).
- Exchanging said first component with said second component in said order includes... The invention of Henson also includes a means of exchanging a first component with a second component. As disclosed in Henson, when the customer selects an alternate component, the product then includes the alternate component in the order. Payment and delivery for the product with the alternate component is then completed, thus, "fulfilling the order with the second component" [see at least: col. 5, lines 15-18].
- Providing a notification regarding said exchanging said first component with said second component... "Notification regarding the exchange of a first a component with a second component" is also exemplified by Figures 3A-3C of Henson. Once

the user has selected an alternate component, the interface displays an updated screen with the currently selected component included as part of the product.

- Fulfilling said order using said second component As taught in Henson, when the customer selects an alternate component, the product then includes the alternate component in the order. Payment and delivery for the product with the alternate component is completed as outlined above, thus, “fulfilling the order with the second component” [see at least: col. 5, lines 15-18].

**Pertaining to Claims 11, 12, and 24:**

- Adjusting a price associated with said order as a result of said exchanging said first component with said second component. A price adjustment means is also incorporated into the invention of Henson as discussed in Claims 11, 12, and 24 of the present invention. According to the invention of Henson, the pricing option module contains a pricing update function to change the price in accordance with the selection of different components [see at least: col. 6, lines 21-25].
- Providing notification regarding said price. The pricing update module outlined above also incorporates the a means of displaying the pricing update to the user reflecting any changes to the system [see at least: col. 6, lines 21-25].

**Pertaining to Claims 15-19:**

- Order identifies at least one characteristic associated with said product. As set forth in paragraph 14 of this paper, the invention of Henson includes

“merchandising recommendations” for the available options (i.e. components) and their respective details (i.e. characteristics and attributes) [see at least: col. 3, lines 12-14]. The product, then, consists of the selected components with identified characteristics and attributes as specified by the user.

- Receiving identification of said at least one characteristic regarding said orde.  
Determining said second component based on , at least in part, said  
characteristic, and determining said non-binding attribute, at leas in part, on said  
characteristic. As set forth in above, the invention of Henson includes “merchandising recommendations” for the available options (i.e. components) and their respective details (i.e. characteristics and attributes) [see at least: col. 3, lines 12-14]. The user interface allows the presentation and identification of option details. Furthermore, Henson facilitates the interchanging of components by allowing customers to view product information and option details, customize the product based on customer preference of options (i.e. based on the details of those options), price the newly customized product, and purchase the customized product [see at least: col. 4, lines 43-46] in order to advantageously enable system configuration and ordering [see at least: col. 4, lines 60-61]. The customization aspect of the invention, in turn, encompasses the concepts of characteristic identification, attribute identification, and the determination of components based on the identified characteristics and attributes.

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**Pertaining to Claim 26:**

- Providing said product. As discussed above, Henson discloses a system of delivery of the product to the customer with the selected components [see at least: col. 5, lines 15-18], thus providing the product as in Claim 26 of the present invention.

**Pertaining to Claim 42:**

- A system for facilitating an order for at least one product. Henson discloses the method of developing an order for a product as set forth above. Henson further discloses the use of online systems and alternative management systems for facilitating customer orders [see at least: col. 1, lines 50-53]

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. **Claims 8, 20-23, and 25 rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (6,167,383) in view of Kalagnanam et al. (US 6,873,967, herein referred to as Kalagnanam).**

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**Pertaining to Claims 8 and 25:**

Henson teaches all of the above as noted under the 102(b) rejection and teaches the use of option details [see at least: col. 3, lines 12-14] to facilitate the order processing; however, Henson does not define in full the meaning of option details nor does Henson describe the “determination” of the non-binding attribute. Kalagnanam discloses the invention of Claim 8 [see at least: col. 5, lines 8-11], defining attributes as being any one of size, color, price, on hand inventory, etc., as well as the invention of Claim 25 [see at least: col. 5, lines 28-31], specifying user input (i.e. determination) as key to merchandise recommendations. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system and method of Henson in order to define attributes as taught by Kalagnanam in order to enhance cyber shopping and thereby allow for the development of an enriching relationship between the customer and retailer [Kalagnanam et al., col. 3, lines 60-64], increasing return customers and improving profits.

**Pertaining to Claims 20-23:**

Henson teaches all of the above as noted under the 102(b) rejection and teaches the use of option details but fails to define in full option details and specify the identification of one or more characteristics. Kalagnanam discloses a database accessed by the online store servers that contains product information used to generate shopping lists based on a shopper's input criteria [see at least: col. 5, lines 28-31]. Furthermore, the input includes such information as item choices, profiles, constraints,

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and limit prices [see at least: col. 5, lines 65-66]. The shopping assistant also allows for the sending and receiving of one or more inputs of constraints and one or more output lists of recommended product combinations [see at least: col. 5, lines 43-51]. From the user input, product combinations are listed that satisfy the constraints specified by the user [see at least: col. 5, lines 21-23]. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the system and method of Henson to incorporate identification of characteristics as taught by Kalagnanam in order to enhance cyber shopping by allowing for the development of an enriching relationship between the customer and retailer [see at least: Kalagnanam, col. 3, lines 60-64].

**14. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson (6,167,383) in view of Official Notice (regarding well within the skill).**

Henson teaches all of the above as noted under the 102(b) rejection and teaches the use of premier pages for specific customer sets [see at least: col. 14, lines 35-61] but does not teach filling a second order with the a first component. Customer sets constitute a group of customers comprised of individual customers within the group. The Examiner takes the position that it is well within the skill, based on the teachings of Henson, that a second order could be established using the original configuration with original components. Furthermore, It is also reasonable to note that a second order established within the customer set would constitute establishing a second order with a second customer. It would have been obvious to one of ordinary skill in the art at the time of invention to modify Henson to include the establishment of a second order using

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the initial components in order to improve responsiveness to customer requests and completeness in servicing demand for personal computer related information [see at least: col. 3, lines 50-54].


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Allen whose telephone number is (571) 272-1443. The examiner can normally be reached on 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W. Coggins can be reached on (571) 272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WJA

  
WYNN W. COGGINS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3625